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EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 04/07/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/702,318

Applicant(s)

WHITAKER ET AL.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 10-12 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

In view of the Appeal Brief filed on September 3, 2003, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 8, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation "the path" in line 3. There is insufficient antecedent basis for this limitation in the claim. Also, the term "path" is indefinite; as it is not clear how this term limits the scope of the claim. Claim 8 recites the limitation "framework software means". Under 35 USC 112, ¶6, "means plus

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function" language is to be examined in light of the specification. Such language must include "means for" performing such function. The language of claim 8 makes it unclear whether applicant is attempting to invoke this section of 35 USC 112. Appropriate correction is required. Claim 14 is rejected for similar reasons, as the claim recites a "server means" without making clear whether 35 USC 112, ¶6 is to be invoked.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert in view of Ziv-El. Siefert discloses in column 8, line 53 to column 9, line 21 of the specification a system and method of delivering lessons to a user over a computer comprising the steps of assessing a user's educational standing, based on the number and type of lessons previously completed, and making a lesson available to the user based on the assessment. Siefert fails to disclose that a number of lesson options are presented to the student to allow the student to choose from a list of appropriate lessons. Ziv-El discloses in column 20, lines 20-22 and in column 24, lines 9-11 a system and method of delivering lessons to a user whereby the user can access a list of available lessons based on the educational standing of the user by pressing

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button 163, and then selecting one of the lessons to work on. It would have been obvious to one of ordinary skill in the relevant art to modify the method disclosed by Siefert by providing a list of appropriate lessons from which a user may select one for the purpose of allowing the user to choose from a plurality of available lessons in selecting a lesson to be received. Although icons are not explicitly disclosed by Siefert or Ziv-El, Official Notice is taken that icons are a widely known means of allowing a user to choose from a list of options on a computer. With respect to claim 3, Siefert discloses in column 9, line 23 to column 10, line 63 that lessons are provided based on a path taken by the student. With respect to claim 4, Siefert discloses in column 4, line 65 to column 5, line 7 that the lessons are delivered over a public-access network. With respect to claims 5 and 14, Ziv-El discloses in column 6, lines 5-6 that the network used to transmit information comprises packet switching communication protocol. It would have been obvious to one of ordinary skill in the relevant art to modify the method disclosed by Siefert by providing a packet switched network for the purpose of facilitating transmittal of information over the network. With respect to claim 7, Official Notice is taken that it is well known to display "active" and "inactive" icons, where the user can initiate a sequence only by selecting an "active" icon, as for example in computer games where certain advanced scenarios are not available for selection until certain tasks are performed. Displaying icons in this manner would have been obvious to one of ordinary skill in the relevant art for the purpose of allowing the user to view unavailable as well as available lessons, to see what may be available in the future. With respect to claim 8, the disclosure of Siefert in column 9, lines 1-5 that lesson 13 is

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presented after lessons 1-12 have been completed amounts to a course structure file which indicates whether prerequisite courses are to be taken before presentation of a given lesson. With respect to claims 10, Official Notice is taken that it is well known to display additional icons upon achievement of certain tasks, as for example in computer games where certain advanced scenarios are not available for selection until certain tasks are performed.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert in view of Ziv-El, and further in view of Parry. Siefert as viewed in combination with Ziv-El discloses all of the limitations of the claims with the exception of the step of removing selected icons. Parry discloses in column 2, line 62 to column 3, line 20 a method of presenting lessons over a computer whereby the computer detects when a student has mastered a concepts and removes those concepts from study until the next review session. It would have been obvious to one of ordinary skill in the relevant art to modify the method disclosed by Siefert as viewed in combination with Ziv-El by providing a step of selectively removing icons for the purpose of allowing the user to more easily focus on concepts not yet mastered. While Parry does not explicitly disclose that icons are removed, Parry suggests the claimed limitation because it is directed to the same concept of removing items from a user's display during an educational process for the same purpose of allowing the student to focus on concepts that have not yet been mastered.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert in view of Ziv-El, and further in view of Truluck. Siefert as viewed in

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combination with Ziv-El discloses all of the limitations of the claims with the exception of the step of refraining from making lessons available at certain predetermined times.

Truluck discloses in column 4, line 55 to column 5, line 5 a method of presenting lessons over a computer whereby the computer detects certain time periods and refrains from presenting the lessons during those time periods. It would have been obvious to one of ordinary skill in the relevant art to modify the method disclosed by Siefert as viewed in combination with Ziv-El by providing a step of refraining from making lessons available at certain predetermined times for the purpose of pacing the user properly and constructing a reasonable study plan.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert in view of Ziv-El and Parry, and further in view of Truluck. Siefert as viewed in combination with Ziv-El discloses all of the limitations of the claim with the exception of the step of refraining from making lessons available at certain predetermined times. Truluck discloses in column 4, line 55 to column 5, line 5 a method of presenting lessons over a computer whereby the computer detects certain time periods and refrains from presenting the lessons during those time periods. It would have been obvious to one of ordinary skill in the relevant art to modify the method disclosed by Siefert as viewed in combination with Ziv-El by providing a step of refraining from making lessons available at certain predetermined times for the purpose of pacing the user properly and constructing a reasonable study plan.

Allowable Subject Matter

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Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 8, 14 and 15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 13 is allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose or suggest a system having all of the limitations of claims 8, 13 and 14. Because the subject matter of the claims has been recited using means-plus-function language, the claim has been examined under 35 USC ¶6, which states that to read on a claimed invention, the prior art must disclose or suggest a device which performs the same function in substantially the same way, when viewing the invention in light of the specification. While the prior art recited reads on other claims, which are written more broadly, none of Siefert, Ziv-El, Truluck and Parry, either alone or in combination suggest the specific function of claim 13. In particular, the present invention has a specific method of determining a predetermined level of educational standing, as discussed at pages 7-12 of the specification.

With respect to claim 6, after further review it has been determined that the Official Notice previously taken was not proper. The subject matter of the claim is not fairly disclosed or suggested in the prior art.

Response to Arguments

Applicant's arguments filed on September 3, 2003 with respect to claims 1-5, 7, 10, 11, 12 and 16-18 have been fully considered but they are not persuasive.

With respect to claims 1-5 and 7, the prior art viewed in combination suggests the claimed invention. Applicant asserts that the prior art fails to disclose two groups of lessons. However, Siefert as viewed in combination with Ziv-El disclose two such groups. Siefert in particular discloses in column 9, lines 1-5 a first broad group of lessons; lessons 1-60 pertaining to analytic geometry. Siefert further discloses a second group, consisting of lesson 13, which is made available to the student based upon the student's educational standing. Ziv-El discloses in column 24, lines 9-11 the expansion of the second group of lessons beyond one, to allow a student to select from a plurality of lessons which are made available based upon a student's educational standing. As a result, Siefert as viewed with Ziv-El reads on this particular limitation. With respect to claim 3, the term "path" is indefinite, as discussed above. Also, Siefert reads on the claim language. Siefert discloses in column 9, lines 1-5 one example of a path which is used to determine an educational standing. In this case, the student has successfully completed lessons 1-12, resulting in lesson 13 being made available.

Applicant further argues that Siefert may disclose an assessment of the student, but does not disclose the assessment claimed by applicant. Claim 1 recites the step of "making an assessment". Nowhere in claim 1 is the assessment further detailed. It is not clear how Siefert can claim an assessment but not the assessment of claim 1, when claim 1 does not recite any particular features of such an assessment. Siefert, in column 7, line 11 to column 8, line 51 disclose a step of making an assessment of a

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student. Siefert further discloses, in column 8, line 61 to column 9, line 11 using an assessment of the student to select a lesson to present to the student. While Siefert does not disclose providing a list of lessons here, Ziv-El discloses this feature, as discussed above. The connection of the assessment to the available lesson is disclosed by Siefert; Ziv-El, merely expand the "lesson" available to a plurality of lessons.

With respect to the arguments concerning the combination of references, allowing the user a wider of options to choose from is inherent in the teachings of Ziv-El. The combination of references leads to "greater autonomy" within the method of claim 1. The rationale leads to the combination of references because Siefert discloses the other limitations of the claims, and because Ziv-El teaches "greater autonomy" than the method of Siefert alone.

The arguments concerning the icons of claim 1 are particularly unpersuasive. Icons are an **extremely** common feature to allow a user to select a document or program on a computer. Virtually every major computer system has, for many years, included icons on a display as a means to allow a user to select a particular document or program for viewing. Each of these icons corresponds to a particular document, or to a particular program. The fact that other types of icons also exist, such as those on video games and those described by applicant on page 13 of the Brief, does not obviate the fact that icons exist and have existed in a wide variety of computer applications for the purpose of allowing a user to select and view a particular document or program.

Allowability cannot possibly be predicated on the inclusion of icons which are selected by a user to view a selected lesson.

With respect to claim 10, applicant has argued that the prior art fails to show all of the limitations of the claims. However, the Noticed material relied upon shows the step of presenting additional icons on a display when a person has attained predetermined prerequisites. These prerequisites pertain to scenarios in a video game, rather than lessons. However, the method of the video games is considered to be analogous to a method of presenting lessons, in that a user must achieve predetermined goals before moving on to new goals. The teachings of Siefert and Ziv-El, when viewed in combination with those of the prior art relied upon in the Official Notice, suggest the subject matter of claim 10. For similar reasons, the rejection of claim 7 is maintained. The video games relied upon in the Official Notice taken in the rejection of claim 7 are analogous to the educational methods of Siefert and Ziv-El because both are broadly directed to methods whereby in that a user must achieve predetermined goals before moving on to new goals. The inactive icons of the video games serve the same purpose as those of the present invention, because in both cases such icons allow a user to view material which may not yet be selected, but which may be selected in the future upon completion of some required prerequisite. It is not clear why applicant argues on pages 15-18 that claim 7 does not recite these advantages. These features appear to be the purpose of the inactive icons recited in claim 7. If applicant has different reasons for including these inactive icons, applicant is respectfully requested to indicate what these purposes would be. Applicant's "Reductio

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ad Absurdum" does not appear to be relevant to the issues at hand, since the video games relied upon and the claim both recite the physical structure of some icons not providing a display when selected by the user. Applicant's analogy of a corkscrew to a hand thus is poor.

Applicant's arguments with respect to claims 11 and 12 have been considered but are moot in view of the new ground(s) of rejection.

The arguments pertaining to the rejections of claims 16-18 are unpersuasive. Applicant has argued that Truluck discloses withholding lessons from a single user's display, while the present invention prevents all students from seeing lessons during the period. Applicant is arguing features not present in the claims. There is no reference to a plurality of students, or to a plurality of displays. Claims 1, 10 and 12, from which claims 16, 17 and 18 respectively depend, are all explicitly directed to a single display, used by a single person. Applicant argues that "all students being prevented from viewing a lesson at a given time" is a necessary implication of claim 16. "The display" does not necessary or even somewhat imply "all displays", using either elementary logic or basic principles of patent law, particularly where a single display has been explicitly recited, and nowhere in any of the claims has more than one display been recited. Truluck clearly discloses a method comprising a step of refraining from making lessons available on a single display. The limitations of claims 16-18 as written do not overcome the teachings of Truluck.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF
April 5, 2004

Kurt Fernstrom
Kurt Fernstrom